

REMARKS

Claims 2-37 are pending. Claims 3, 4, 10, 12-21, 24, 25 and 35-37 are withdrawn from consideration as being drawn to a nonelected invention and claims 6-8 and 11 are withdrawn from consideration as being drawn to a nonelected species.

Claim 1 has been canceled without prejudice.

Claim 2 has been amended to recite methods of treatment and to clarify that "MD" is macular degeneration.

Claims 26-28, 33 and 34 have been amended to depend from claim 2.

Claims 29-32 have been amended to depend from claim 23.

Claim 22 has been amended to depend from claim 9.

No new matter has been added.

Applicants reserve their right to prosecute the subject matter of any canceled claim, any amended claim, any withdrawn claim or any unclaimed subject matter in one or more related applications.

I. The Rejection of Claims 1, 2, 5, 9, 22, 23 and 26-34 Under 35 U.S.C. § 112, First Paragraph

Claims 1, 2, 5, 9, 22, 23 and 26-34 are rejected under 35 U.S.C. § 112, first paragraph, for allegedly lacking enablement.

In particular, while acknowledging that the specification is enabling for treating macular degeneration, the Examiner has stated that it does not reasonably provide enablement for the prevention of macular degeneration.

Without acquiescing in the rejection and solely to expedite prosecution of the present application, Applicants have amended claim 2 to recite methods of treatment. Claim 1 has been canceled without prejudice. Claims 5, 9, 22, 23 and 26-34 depend directly or indirectly from claim 2.

Accordingly, Applicants submit that the rejection of claims 1, 2, 5, 9, 22, 23 and 26-34 under 35 U.S.C. § 112, first paragraph, has been overcome and should be withdrawn.

II. The Rejection of Claims 1, 22 and 26-34 Under 35 U.S.C. § 112, First Paragraph

Claims 1, 22 and 26-34 are rejected under 35 U.S.C. § 112, first paragraph, for allegedly lacking enablement.

In particular, while acknowledging that the specification is enabling for the treatment of macular degeneration with a JNK inhibitor of formula I, the Examiner has stated that it does not reasonably provide enablement for all JNK inhibitors.

Without acquiescing in the rejection and solely to expedite prosecution of the present application, Applicants have canceled claim 1 without prejudice and amended claims 22, 26-28, 33 and 34 to depend from claim 2.

Accordingly, Applicants submit that the rejection of claims 1, 22 and 26-34 under 35 U.S.C. § 112, first paragraph, has been overcome and should be withdrawn.

III. The Rejection of Claims 1, 22 and 26-34 Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 22 and 26-34 are rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. In particular, the Examiner has stated that the term “JNK inhibitor” is indefinite.

Without acquiescing in the rejection and solely to expedite prosecution of the present application, Applicants have canceled claim 1 without prejudice and amended claims 22, 26-28, 33 and 34 to depend from claim 2.

Accordingly, Applicants submit that the rejection of claims 1, 22 and 26-34 under 35 U.S.C. § 112, second paragraph, has been overcome and should be withdrawn.

IV. The Rejection of Claims 1, 2, 5 and 9 Under 35 U.S.C. § 103(a)

Claims 1, 2, 5 and 9 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over WO 02/10137 A2 to Bhagwat *et al.* (“Bhagwat”) in view of U.S. Patent No. 6,949,580 B2 to Hale *et al.* (“Hale”). In particular, the Examiner has stated that Bhagwat teaches that indazole derivatives of formula I inhibit JNK (a protein kinase) and that Hale teaches that protein kinase inhibitors are useful for treating ocular diseases, such as macular degeneration. Applicants disagree and respectfully traverse this rejection.

The disclosure of Hale pointed to by the Examiner as teaching that protein kinase inhibitors are useful for treating ocular diseases, such as macular degeneration, actually teaches that KDR family kinases are useful for treating such diseases (*see* Hale at column 21, lines 30-44). In other words, Hale does not teach that kinase inhibitors in general are useful for treating ocular diseases.

With respect to JNK inhibitors, Hale provides a specific definition “JNK-mediated conditions,” which does not include ocular diseases or macular degeneration (*see* Hale at column 21, lines 1-22). Notably, Hale does teach that kinases have distinct differences in

how their pathways are activated, specifically pointing to the differences between the activation of the JNK and ERK pathways (*see* Hale at column 1, lines 31-40). Accordingly, rather than suggesting the use of a JNK inhibitor to treat macular degeneration, Applicants respectfully submit that the disclosure of Hale when read in its entirety actually teaches away from such use.

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been established because no reason has been provided as to why one of ordinary skill in the art would use the compounds of the pending method claims for the treatment of macular degeneration. Without such a reason, Applicants respectfully submit that a proper *prima facie* case of obviousness has not been established ([T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR International Co. v. Teleflex Inc.* 127 S.Ct. 1727 (2007)).

Accordingly, Applicants submit that the rejection of claims 1, 2, 5 and 9 under 35 U.S.C. § 103(a) has been overcome and should be withdrawn.

V. The Rejection of Claims 22, 23 and 26-34 Under 35 U.S.C. § 103(a)

Claims 22, 23 and 26-34 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bhagwat and Hale in view of U.S. Patent No. 6,204,270 B1 to Ron *et al.* (“Ron”) and Applicant’s alleged admission of the prior art.

Because, for the reasons set forth above, Hale does not provide any reason as to why one of ordinary skill in the art would use the compounds of the pending method claims to treat macular degeneration, Applicants respectfully submit that a proper case of *prima facie* obviousness over Bhagwat and Hale in view of Ron has not been established. *Id.*

Accordingly, Applicants submit that the rejection of claims 22, 23 and 26-34 under 35 U.S.C. § 103(a) has been overcome and should be withdrawn.

Conclusion

Applicants respectfully request that the above remarks be entered in the present application file. No fee is estimated to be due in connection with this Response other than that due in connection with the Petition for Extension of Time; however, in the event that any additional fee is due, please charge the required fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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